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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,424	07/27/2001	David Frederick Bantz	YOR920010452US1	8854

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EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,424

Applicant(s)

BANTZ ET AL.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/27/2001</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

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1. Claims 1-30 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
4. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-30 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear as indicated below.
6. Phrases such as "the portable computer" (claim 1 (line 3), claim 11 (line 5), and claim 21 (line 4)) are but a few examples of numerous cases where clear antecedent bases are lacking and not an exhausting recital (i.e., and not limiting hereto "the highest score" in claim 4 (line 4) and other such claims throughout all thirty claims). A "portable data processing system", not "portable computer", was originally introduced, thus examiner is not certain if the two are the same in each of the claims. Any other term(s) or phrase(s) overlooked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent bases also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introduction of a term, or changes in tense, results in a lack of clear antecedent bases for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent bases are lacking can be viewed as non-responsive.
7. The method claims are indefinite since it cannot be clearly ascertained who or what is performing the claimed invention (i.e., human or machine). Since examiner cannot be certain if the claims are directed to landmark observations, examiner is unable to apply a proper rejection under 35 U.S.C. 101 "mental steps". For example, examiner can ascertain location within a building by observing the presences or absences of certain types of photocopier machine even

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though some are the same between floors by noticing the presences of a fax machine not present on another floor. Such acts are “mental steps”.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-30 are rejected under 35 U.S.C. 102 (b) as being anticipated by Norris (5,557,748).

10. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

11. Per claim 1, Norris taught a method (e.g., see figure 4 and col. 2 (lines 58-59)) of determining a location (e.g., see Abstract and figure 4 (450) with col. 10 (line 58-et seq.) and also col. 8 (lines 54-65)) of a portable data processing system (e.g., see last two words of col. 10 (line 66)), the method comprising:

- a) determining resources geographically proximate to the portable computer to generate a location syndrome (e.g., see Abstract, col. ;
- b) comparing the location syndrome (e.g., see col. 10 (line 58 “current participants list”)) to a set of location profiles (e.g., “network participants list” and/or “existing participants list”) per col. 5 (line 7-et seq.), col. 10 (line 58-et seq.), and col. 11 (line 6)); and,
- c) responsive to sufficiently matching (e.g., see figure 4 (470)) the location syndrome to one of the set of location profiles, returning, to another software component (e.g., that software which configures the network parameters into the portable computer), a label corresponding to a matched one of the set of location profiles as a current location of the portable data processing system per col. 11 (line 11-et seq.)).

12. Thus, per above, akin with human performed like steps, one can infer ones location to be that of New York City by observing the Statutory of Liberty geographically proximate the observer, Washington D.C. by observing the Washington Monument, or Cape Canaveral even though the environment is similar to the moon (i.e., moon simulator at a local Carnival), by observing NASA's launch pad. As in Norris, resources are used as landmarks to infer location; the more the distinct landmarks, the more accurate the result (i.e., two network having the same

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type of printer fails to distinguish one location over another as does a unique scanner at just one of the two locations).

13. Per claims 2, 3, 4, and 5, in addition to seeing above, see col. 8 (line 35-et seq.) such implied Ven Diagramming inference is ranking the match results to infer a more accurate determination of location with user selection per col. 10 (last line) for final confirmation.

14. Per claims 6 and 7 see col. 9 (line 56-et seq.)) for "at least one of" limitation.

15. Per claims 8, 9 and 10, see col. 6 (line 10-et seq.), col. 7 (line 15-et seq.) and col. 9 (line 1-et seq.). Along with the given example of col. 9 (lines 10-15), as is "PING", TCP/IP environments also contain innocuous command "traceroute" (e.g., see col. (line 10-15) that goes hand-in-hand with network discovery; and, along with "PING", gives behavior information of the network (i.e., congested along with time of day).

16. Per claims 11-20, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

17. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (571) 272-3896. The fax phone number for all papers is (703) 872-9306.

20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142